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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/731,326	12/08/2003	Gary G. Baldwin	7737.00008	5047
29747	7590	07/05/2007		
GREENBERG TRAUIG 3773 HOWARD HUGHES PARKWAY SUITE 500 NORTH LAS VEGAS, NV 89169			EXAMINER HSU, RYAN	
			ART UNIT	PAPER NUMBER
			3714	
			MAIL DATE	DELIVERY MODE
			07/05/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/731,326

Applicant(s)

BALDWIN, GARY G.

Examiner

Ryan Hsu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) 14-40 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 12/08/03
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-13, are drawn to the specific structure of a scratch off lottery ticket comprising a first ticket portion and a second ticket portion this is subject matter is classified in class 463, subclass 17.
- II. Claims 14-40, are drawn to a lottery system that comprises a scratch off lottery ticket with a bar code and a plurality of networked game devices or the incorporation of a networked player tracking system into a lottery ticket program or the lottery ticket program that provides the player with a bonus game in a networked system. The subject matter of these claims are classified in class 463, subclass 42.

The inventions are distinct, each from the other because of the following reasons:

Group I of the applicant's application is directed towards the structure of a scratch off lottery ticket which calls for a first ticket portion sponsored by a lottery including a game of chance and a second ticket portion sponsored by a non-lottery party associated with the business of the non-lottery party. This is opposed to the subcombination that is recited in the claims of Group II of the instant application, which does not require the particularities of the combination for patentability because:

a) it is directed towards the system to manage and monitor the actual lottery system. The implementation of a lottery system using networked devices that have the ability to track player operations allow the play of bonus games has a separate utility than just the lottery ticket of Group I.

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Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because a player tracking device or networking gaming devices does not necessarily require the specific structure of the lottery ticket of Group I. The subcombination has separate utility such as a player tracking device, networking systems of gaming devices and barcodes have a separate utility to be used for as a voucher gaming system or a casino management system and is not limited to be used with only the lottery ticket of group I.

The examiner has required restriction between combination and subcombination inventions. Where applicant elects a subcombination, and claims thereto are subsequently found allowable, any claim(s) depending from or otherwise requiring all the limitations of the allowable subcombination will be examined for patentability in accordance with 37 CFR 1.104. See MPEP § 821.04(a). Applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classifications, restriction for examination purposes as indicated is proper.

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Furthermore, in a telephone call made to Robert Phillips (Reg. No. 40,305) on 6/11/07 to request an oral election to the above restriction requirement. The applicant's representative has elected to continue prosecution with **group I (Claims 1-13)**.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 1, 6, and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Mullins (US 5,158,293).**

Regarding claim 1, Mullins discloses a scratch off lottery ticket comprising: a first ticket portion sponsored by a lottery, where the first portion includes a game of chance (*see 'lottery game draw' [10] of Figs. 1-2 and the related description thereof*) and a second ticket portion sponsored by a non lottery party that includes a potential prize giveaway associated with the business of the non lottery party (*see 'instant game' [11] of Figs. 1-2 and the related description thereof*).

Regarding claim 6, Mullins discloses a lottery ticket comprising: a first section for providing a game of chance wherein game prizes are redeemed through a lottery system (*see 'instant game' Fig. 1-2 and the related description thereof*) and a second section for offering rewards associated with a non lottery entity wherein the rewards are redeemed at a location operated by the non lottery entity location (*see vouchers [76] of Fig. 7 and the related description thereof*).

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Regarding claim 12, Mullins discloses a scratch off lottery ticket comprising: a first section offering a game of chance (*see 'lottery game draw' [10] of Figs. 1-2 and the related description thereof*) and a second section offering game device credits (*ie: cash prize*)(*see 'instant game' [11] of Figs. 1-2 and the related description thereof*).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 2-5, 7-11, and 13 rejected under 35 U.S.C. 103(a) as being unpatentable over Mullins as applied to claims above, and further in view of Clapper Jr. (US 6,056,289).**

Regarding claims 2 and 9, Mullins teaches a lottery ticket however is silent with respect to it being associated with a prize from a non lottery party such as a casino. However in a related gaming patent, Clapper teaches a lottery ticket that associates prizes with an establishment (*ie: telephone access, sporting event, specific good or service*)(*see col. 5: ln 5-35*). Therefore the lottery ticket is capable of having the non lottery party be a casino. One would be motivate to incorporate such a feature into a lottery ticket of Mullins in order to provide some sort of promotional game or incentive for playing the lottery ticket. Thus it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the features of Clapper with that of Mullins.

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Regarding claim 3 and 10, Mullins discloses a lottery ticket wherein the potential prize giveaways include one or more of the potential prizes in the group consisting of cash prizes, free casino play and discounted or free casino amenities (*see col. 3: ln 12-40*).

Regarding claims 4, 11, and 13, Mullins teaches a lottery ticket that comprises of a first section offering a game of chance and a second section offering a potential prize giveaway. However, Mullins is silent with respect to a lottery ticket that has a bar code that is readable by a game device such that free casino play or games may be redeemed by inserting the portion of the ticket including the bar code into the game device. In a related lottery ticket patent, Clapper teaches a lottery ticket that has a bar code that is readable by a game device such that free casino play or games may be redeemed by inserting the portion of the ticket including the bar code into the game device (*see col. 13: ln 50-col. 14: ln 22*). One would be motivated to incorporate a bar code with the lottery ticket of Mullins in order to provide a verification mechanism so that tickets could not be easily forged. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the features of Clapper with that of Mullins to incorporate a bar code verification mechanism into a lottery ticket.

Regarding claims 5 and 7-8, Mullins discloses a lottery ticket that comprises a perforation for separating the first and second ticket portions from one another (*see perforation [40] of Fig. 1 and the related description thereof*).

### ***Conclusion***

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The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

**Behm et al. (US 6,899,621 B2)** – System and Method for Selling Lottery Game Tickets.

**Guittin et al. (US 6,241,246)** – Lottery Ticket and Word Game Played Thereby.

**Scrymgeour et al. (US 6,347,794 B2)** - Combination Instant Scratch-Off/ Break-Open Ticket.

Any inquiry concerning this communication or earlier communication from the examiner should be direct to Ryan Hsu whose telephone number is (571)-272-7148. The examiner can normally be reached on M-F 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert E Pezzuto can be reached at (571)-272-6996.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, contact the Electronic Business Center (EBC) at 1-866-217-9197 (toll-free).

RH 

June 11, 2007

/Scott Jones/

Primary Examiner, Art Unit 3714